

REMARKS

In the Action, claims 1, 2, 4-7, 9-11 and 13-18 are rejected. In response, claim 1 is amended to clarify that the resulting mixture comprises the cis and trans-3,3,5-trimethylcyclohexyl ester. The amendment to claim 1 relates solely to a matter of form. Claims 7 and 13-18 are amended to recite the amount of the cis-3,3,5-trimethylcyclohexyl ester being present in an amount of 0.1 to 90 wt% based on the total weight of the composition as disclosed on page 13, lines 11-14 of the specification. New claims 24-27 depend from claim 7 to recite the amount of the cis enantiomer relative to the fragrance components and the trans enantiomer and the amounts of the cis enantiomer disclosed on page 13 of the specification.

In view of the following comments, reconsideration and allowance are requested.

Claims 1, 2, 7-9 and 13-18 are rejected under 35 U.S.C. § 103(a) as being obvious over Eliel et al. from the *Journal of Organic Chemistry*, 1970, Vol. 35 (8), pages 2716-2722. The Action refers to page 2722 as disclosing the conversion of cis-3,3,5-trimethylcyclohexanol to its acetate by treatment with acetic anhydride and pyridine.

Eliel et al. clearly does not disclose or suggest a mixture of (1) one or more cis-3,3,5-trimethylcyclohexyl esters and (2) one or more trans-3,3,5-trimethylcyclohexyl esters as expressly recited in claim 1. The Action appears to suggest that claim 1 does not require the trans-3,3,5-trimethylcyclohexyl ester even though the claim positively recites the trans isomers. Applicants respectfully submit this position is contrary to the express language of claim 1. Furthermore, the interpretation in the Action that the trans-3,3,5-trimethylcyclohexyl esters are not required disregards the language of the claim requiring a “mixture”.

Claim 1 expressly recites a mixture comprising one or more cis and one or more trans-3,3,5-trimethylcyclohexyl esters, and thus, expressly requires the two isomers in the amounts

recited. The claim language defining the amount of the respective amounts of the cis and trans isomers does not avoid the plain language of the claim. One skilled in the art would not consider claim 1 as requiring only the cis isomer as suggested in the Action as such an interpretation ignores the wording of the claim and would not result in a mixture. Claim 1 specifically requires the mixture of the cis and trans isomers where the cis isomer in the mixture is present in an amount of at least 80 wt% and where the trans-3,3,5-trimethylcyclohexyl ester is present in the mixture in an amount of not more than 20 wt%. Claim 1 only places an upper limit in the amount of the trans-3,3,5-trimethylcyclohexyl ester in the mixture and does not encompass a complete absence of the trans-3,3,5-trimethylcyclohexyl ester as suggested in the Action.

Eliel et al. as noted in the Action discloses only the conversion of cis-3,3,5-trimethylcyclohexanol to the acetate. There is no disclosure or suggestion of the trans-3,3,5-trimethylcyclohexyl ethyl ether or the corresponding acetate. Furthermore, Eliel et al. provides no suggestion to one skilled in the art to provide a mixture comprising one or more cis-3,3,5-trimethylcyclohexyl esters and one or more trans-3,3,5-trimethylcyclohexyl esters as recited in claim 1. The Action does not provide any factual basis for the position that it would have been obvious to modify Eliel et al. to provide a mixture of one or more cis-3,3,5-trimethylcyclohexyl esters and one or more trans-3,3,5-trimethylcyclohexyl esters where the cis-3,3,5-trimethylcyclohexyl ester is present in the mixture in an amount of at least 80 wt%. Accordingly, claim 1 is not obvious over Eliel et al.

Furthermore, the interpretation of the amount of the trans-3,3,5-trimethylcyclohexyl ester with respect to claim 2 is not well founded. If as suggested by the Examiner, the trans-3,3,5-trimethylcyclohexyl ester is present in an amount of “0” then the amount of the cis-3,3,5-trimethylcyclohexyl ester cannot be present in an amount of “at least twice as high” as the trans-

3,3,5-trimethylcyclohexyl ester. If the amount of the trans isomer is 0 then the amount of the cis isomer must also be 0 since basic math teaches $0 \times 2 = 0$. Thus, according to the Examiner's interpretation, claim 2 requires neither the cis nor the trans isomers. Eliel et al. does not suggest the trans isomer or a mixture where the cis-3,3,5-trimethylcyclohexyl ester is in an amount at least twice that of a trans-3,3,5-trimethylcyclohexyl ester as in claim 2. Thus, claim 2 is not obvious.

The Action suggests that the product of Eliel et al. would or could be added to a composition, thereby rendering claim 7 obvious. Applicants respectfully submit this position does not establish prima facie obviousness of the claimed method. Claim 7 is specifically directed to a method of enhancing a fragrance note of a composition by adding a cis-3,3,5-trimethylcyclohexyl ester to the composition.

Claims 9-11 and 13-18 are also directed to a method of enhancing a composition to impart a specific scent to the composition. For example, claim 9 is specifically directed to a method of enhancing a composition to impart a fresh and/or fruity scent to the composition. Eliel et al. provides no suggestion or the desirability of using the claimed compounds in a method of enhancing a fragrance. Claim 10 is directed to a process for imparting a fresh or fruity scent in a perfume composition or a perfume product by adding the cis-3,3,5-trimethylcyclohexyl ester of claim 1 to the perfume composition or product. Thus, the claims are specifically directed to a method of enhancing the fragrance of a composition to impart a specific scent.

Applicants respectfully submit that the contention that the claimed method is unpatentable simply because the components used in the method are known is misplaced. The Action suggests that the properties are inherent in the compounds of the cited patents thereby

rendering unpatentable the method of using the compound in a method of enhancing the fragrance notes of a fragrance. However, as stated by the Federal Circuit, “new uses of old products or processes are indeed patentable subject matter”. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 77 USPQ2d 1321 (Fed. Cir. 2005). Moreover, “principals of inherency do not prohibit a process patent for a new use of an old structure”. *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136 (Fed. Cir. 1986). Thus, regardless of whether the compounds disclosed in the cited patents are known or possess inherent properties, the claimed process of enhancing the fragrance of a composition is patentable over the prior patents. The cited articles provide no suggestion to one skilled in the art to enhance a fragrance note of a composition by the addition of a cis-3,3,5-trimethylcyclohexyl ester as in claim 7. The only disclosure or suggestion of such a method is Applicants’ disclosure. Applicants respectfully submit that the rejection improperly relies on the present specification as a guide to obtain the claimed invention.

Thus, the claims are clearly not obvious over the disclosure of Eliel et al. Eliel et al. does not suggest to one skilled in the art a method of imparting a fresh or fruity scent to a composition as in claim 9, a method of imparting a fresh and/or fruity scent to a perfume composition as in claim 10, either alone or in combination with the features of the independent claim.

Eliel et al. also does not suggest a method of enhancing a composition to impart a fresh terpene-like natural nutty or minty scent to a composition as in claim 11.

Eliel et al. also does not suggest to one skilled in the art a method of enhancing a composition to impart, modify or intensify a fresh fruity, terpene-like or apple-like scent as in claim 13 by the addition of cis-3,3,5-trimethylcyclohexyl propionate. As noted in the Action, Eliel et al. does not disclose or suggest the propionate. Regardless of whether the propionate

could have been made according to Eliel et al., this does not render the claimed method of imparting a fresh, fruity, terpene-like or apple-like scent to a composition. It is well known in the art that small changes in the chemical formula of a compound can have a significant effect on the fragrance or taste of a composition. Eliel et al. clearly provides no teaching or suggest to one skilled in the art that modifying the ester group would have any reasonable expectation of being capable of imparting a fresh, fruity, terpene-like or apple-like scent. Moreover, Eliel et al. discloses a single example where the cis-3,3,5-trimethylcyclohexanol is treated with acetic anhydride to obtain the acetate. Eliel et al. provides no teaching how to obtain the propionate. The Action provides no factual basis for the position that Eliel et al. is capable of producing the propionate based on the disclosure of Eliel et al. Eliel et al. does not render the claimed method obvious to one skilled in the art.

Eliel et al. also does not disclose the isobutyrate ester as in claim 14, the butyrate ester as in claim 15, the tiglate of claim 16, the crotonate of claim 17, or the 3-methyl-butenate of claim 18. Thus, it would not have been obvious to one skilled in the art to provide a method of imparting a specific scent to a composition using one or more of these compounds so that claims 14-18 are not obvious over Eliel et al.

Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. § 102(b) as being anticipated by Behura et al. as evidenced by Chowdhury et al. Behura et al. is cited for disclosing an essential oil of *Curcuma longa* (*C. Longa*). As noted in the Action, Behura et al. does not define the composition of the oil extracted from the *C. Longa*.

Chowdhury et al. is relied on for the position that the extract or oil of *C. Longa* obtained according to Behura et al. inherently contains cis-3,3,5-trimethylcyclohexyl acetate. The Action

does not identify where Chowdhury et al. discloses the claimed trans-3,3,5-trimethylcyclohexyl acetate.

For the reasons discussed above, claim 1 expressly requires a mixture of one or more trans and one or more cis-3,3,5-trimethylcyclohexyl esters. Therefore, to disregard one of the expressly recited components of claim 1 is improper and is not a proper claim interpretation. Claim 1 expressly recites the mixture comprising one or more cis-3,3,5-trimethylcyclohexyl esters in an amount of at least 80 wt% and one or more trans-3,3,5-trimethylcyclohexyl esters where the amount of the trans-3,3,5-trimethylcyclohexyl ester is present in an amount of not more than 20 wt%. Contrary to the suggestion in the Action, the language of claim 1 defining the amount of the trans isomer in an amount of not more than 20 wt% does not encompass 0. Such an interpretation disregards the plain language, is contrary to the plain language of the claim, and applies an unreasonable and inconsistent interpretation.

Neither Behura et al. nor Chowdhury et al. disclose a mixture of one or more cis and one or more trans-3,3,5-trimethylcyclohexyl esters. The Action suggests that even though Chowdhury et al. does not disclose the trans isomer, the compound inherently contains the trans-3,3,5-trimethylcyclohexyl acetate in an amount less than the corresponding cis-3,3,5-trimethylcyclohexyl acetate. This position is not based on any factual evidence and is based entirely on speculation. Table 2 relied on in the Action discloses 30 separate components of the essential oil obtained from *C. Longa*. Not one of the compounds identified by Chowdhury et al. is the trans-3,3,5-trimethylcyclohexyl ester. Moreover, Chowdhury et al. expressly discloses only the cis-3,3,5-trimethylcyclohexyl ester. Based on the specific disclosure of Chowdhury et al., one skilled in the art cannot reasonably interpret the extract oil containing an undisclosed component without some factual evidence to support the position.

The Action appears to suggest that even if Chowdhury et al. does not contain the trans ester, the oil reads on the claimed invention. For the reasons discussed above, claim 1 expressly requires a mixture of one or more cis and one or more trans isomers. Moreover, claim 1 expressly requires the mixture to comprise at least 80% of the cis-3,3,5-trimethylcyclohexyl ester. As noted in the Action, the only composition disclosed in Chowdhury et al. contains 0.55% of the cis-3,3,5-trimethylcyclohexyl ester.

Moreover, Chowdhury et al. does not demonstrate that the essential oil of Behura et al. inherently contains the cis-3,3,5-trimethylcyclohexyl acetate. Behura et al. refers only to a cured dried and ground rhizome as a supporting constituent of curry powders and as a food colorant. The plant materials are disclosed as being designated by its pleasant camphoraceous aroma of the rhizome. Behura et al. also discloses that the main constituents are the turmerone, turmerol and attantone. Chowdhury et al. expressly discloses that the different types of *C. Longa* contain different compounds in different amounts. Specifically, Table 1 referred to in the Action discloses the constituents of the yellow variety of *C. Longa* which contains 54 different compounds, none of which is the cis-3,3,5-trimethylcyclohexyl acetate. Table 2 of Chowdhury et al. discloses only 39 constituents of the red variety of *C. Longa*, many of which are different from the compounds identified in Table 1. Behura et al. does not identify whether the plant component is the yellow variety or the red variety. Thus, it is impossible to determine which variety Behura et al. used to obtain the oils and according to Chowdhury et al. it is impossible to determine whether the oil disclosed in Behura et al. contains every compound disclosed in Chowdhury et al.

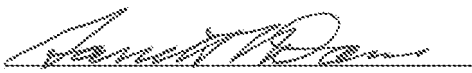
In view of the deficiencies of Behura et al. and Chowdhury et al., independent claim 1 is not anticipated.

Claims 2, 4 and 5 are also not anticipated for reciting additional features of the invention. Claim 2 expressly requires a mixture where the proportion of cis-3,3,5-trimethylcyclohexyl ester is at least twice as high as that of trans-3,3,5-trimethylcyclohexyl ester. Behura et al. and Chowdhury et al. clearly do not disclose the cis isomer being present in an amount twice that of the trans isomer.

Behura et al. and Chowdhury et al. also do not suggest a mixture containing one or more cis-3,3,5-trimethylcyclohexyl esters and one or more trans-3,3,5-trimethylcyclohexyl esters in an amount to provide a fresh or fruity scent as in claim 4, or a fragrance composition comprising at least one fragrance substance and the mixture of claim 1 as in claim 5. Accordingly, claims 2, 4 and 5 are not anticipated by Behura et al. either alone or as evidenced by Chowdhury et al.

In view of the above comments, the claims are submitted as being allowable over the art of record. Accordingly, reconsideration and allowance are requested.

Respectfully submitted,


Garrett V. Davis
Reg. No. 32,023

Roylance, Abrams, Berdo & Goodman, L.L.P.
1300 19th Street, N.W., Suite 600
Washington, D.C. 20036-1649
(202) 659-9076

Dated: Jan 25, 2011